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EXAMINER	
YIMAM, HARUN M	

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,266	WHITE ET AL.	
	Examiner	Art Unit	
	Harun M. Yimam	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7 and 13-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7 and 13-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *see action*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 06/13/2005 and 10/20/2005 have been considered by the examiner.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3-7, and 13-19 have been considered but are moot in view of the new ground(s) of rejection.

3. In response to applicant's argument (page 6, 4th paragraph) that the "office has failed to carry the burden of establishing obviousness", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner cites column 21, lines 50-54, wherein Alexander discusses that the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing and especially column 12, lines 10-21, where Alexander explicitly discloses copying

video programs on a Digital Video Disc (DVD), wherein the copied video programs are obviously maintained after viewing.

4. In response to applicant's argument (page 7, 3rd paragraph) that Hendricks fails to teach or suggest "copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking", the Examiner cites column 38, lines 56-61, wherein Hendricks first discloses monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and column 39, lines 3-6, wherein Hendricks further discloses copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

5. In response to applicant's argument (page 7, 4th paragraph) that the "office has failed to carry the burden of establishing obviousness", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited benefit of freeing storage space when the capacity is reached by overwriting viewed copied video programs, then overwrite non-viewed

copied video programs, see Lazarus—column 2, lines 56-64, column 4, lines 21-29, and column 5, lines 22-26 and

6. In response to applicant's argument (page 8, 4th paragraph) that Herz fails to teach or suggest "automatically cycles through plural selections in the determined affinity grouping", the Examiner cites column 48, lines 42-47, wherein Herz discloses that upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping.

7. In response to applicant's argument (page 9, 2nd paragraph) that Alexander fails to teach or suggest "listing the copied video program in an electronic program guide associated with the system, together with a viewing channel on which the copied video can be viewed", the Examiner cites column 30, lines 53-58, wherein Alexander explicitly discloses listing the copied video in an electronic program guide associated with the system, together with a viewing channel on which the copied video can be viewed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Herz (US 5,758,257).

Considering claim 13, Herz discloses a method of operating a computer implemented interactive entertainment system (column 47, lines 26-29) comprising: logging entertainment selections of plural users (column 41, lines 26-27 and 33-36); generating affinity groupings based on similarities in the entertainment selections logged (column 15, lines 22-29); polling a first user on a user interface to determine the first user's favorite entertainment (column 43, lines 3-6 and column 45, lines 59-63); determining an affinity grouping similar to the first user's favorite entertainment (column 34, lines 31-32); and presenting the first user a listing of available programs favored by members of the determined affinity grouping (column 47, lines 38-42). Herz further discloses that upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping (column 48, lines 42-47).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 6, 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Yoshinobu (US 5,734,444) and further in view of Alexander (US 6,177,931).

Considering claim 6, Herz discloses a method of operating a video system (412—figure 4), the system including a video input (column 40, line 66 – column 41, line 4), a controller (column 45, lines 45-46), and a store (902—figure 9), the method comprising: monitoring a user's viewing habits to determine a favorite broadcast video program (column 14, lines 5-7 and column 42, lines 6-8).

Herz fails to disclose copying the video program to the store if the user is not viewing said program when broadcast. Herz also fails to disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu further discloses that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59).

It would have been obvious to one of ordinary skill in the art to modify Herz's system to include an automatic recording of the favorite program, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program.

Herz and Yoshinobu disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

Herz and Yoshinobu fail to disclose defining plural viewing channels; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing. Herz and Yoshinobu further fail to disclose maintaining the copied video programs are after viewing.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing (column 30, lines 55-58); on at least one of said channels, presenting said copied video

program for viewing (column 21, lines 50-54 and column 22, lines 29-33). Alexander further discloses that the copied video programs are maintained after viewing (the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing—column 21, lines 50-54 and column 12, lines 10-21, where Alexander explicitly discloses copying video programs on a Digital Video Disc (DVD), wherein the copied video programs are obviously maintained after viewing).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

As for claim 1, it is met by the combination of Herz, Yoshinobu, and Alexander. In particular, Herz discloses the method of claim 6 comprising: generating profiles for plural users, said profiles being based, at least in part, on two video viewing habits (column 25, lines 7-13); presenting a listing of available programs that appeared favored by other viewers with profiles similar to the user's viewing habits (column 5, lines 23-52 and column 46, lines 50-57); wherein the system can suggest to a viewer other programs based on similar viewers' preferences (column 22, line 64 – column 23, line 5).

Considering claim 4, it is rejected for the same reasons as discussed in claim 6.

As for claim 5, it is met by the combination of Herz, Yoshinobu, and Alexander. In particular, Alexander discloses listing the copied video program in an electronic program guide associated with the system, together with a viewing channel on which the copied video can be viewed (Alexander—column 30, lines 53-58).

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444) in view of Alexander (US 6,177,931), as applied to claim 6 above, and further in view of Hendricks (US 5,600,364).

With regards to claim 3, Herz, Yoshinobu, and Alexander disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

Herz, Yoshinobu, and Alexander fail to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

In analogous art, Hendricks discloses monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency

(column 38, lines 56-61); and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking (column 39, lines 3-6).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, and Alexander to include determining a ranking of viewed broadcast video program by viewing frequency and storing plural programs in accordance with said ranking, as taught by Hendricks, for the benefit of accommodating the user's viewing preference.

13. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444) in view of Alexander (US 6,177,931) and further in view of Lazarus (US 5,652,613).

Regarding claim 7, Herz discloses a method of operating a video system (412—figure 4), the system including a video input (column 40, line 66 – column 41, line 4), a controller (column 45, lines 45-46), and a store (902—figure 9), the method comprising: monitoring a user's viewing habits to determine a favorite broadcast video program (column 14, lines 5-7 and column 42, lines 6-8).

Herz fails to disclose copying the video program to the store if the user is not viewing said program when broadcast. Herz also fails to disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu further discloses that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59).

It would have been obvious to one of ordinary skill in the art to modify Herz's system to include an automatic recording of the favorite program, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program.

Herz and Yoshinobu disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (Yoshinobu— column 24, lines 51-59).

Herz and Yoshinobu fail to disclose defining plural viewing channels; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing

(column 30, lines 55-58); on at least one of said channels, presenting said copied video program for viewing (column 21, lines 50-54 and column 22, lines 29-33).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

Herz, Yoshinobu, and Alexander fail to disclose that as space is needed in the video system, said copied video programs are overwritten in the following priority, first overwrite viewed copied video programs, then overwrite non-viewed copied video programs.

In analogous art, Lazarus discloses overwriting viewed copied video programs, then overwrite non-viewed copied video programs (column 2, lines 56-64, column 5, lines 22-26 and column 4, lines 21-29).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, and Alexander to include a prioritized overwriting method, as taught by Lazarus, for the benefit of freeing storage space when the capacity is reached.

Considering claim 14, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Herz discloses a corresponding computer readable medium (figure 11 and column 10, lines 6-20 and column 49, lines 32-51) for performing the method of claim 7.

As for claim 15, it is rejected for the same reasons as discussed in claims 5, 7, and 14.

With regards to claim 16, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses listing the automatically copied favorite video program in the favorite channel by title (column 24, lines 21-26) and length (start time and end time—column 14, lines 48-50).

Regarding claim 17, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses automatically playing the copied favorite video program when the favorites channel is selected (column 14, lines 54-57).

Considering claim 18, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses listing

plural copied video programs (Yoshinobu—see figure 10) from which the copied favorite video program can be selected for playback (column 14, lines 48-57).

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257), Yoshinobu (US 5,734,444), and Alexander (US 6,177,931), in view of Lazarus (US 5,652,613), as applied to claim 14 above, and further in view of Daniels (2002/0032907).

As for claim 19, Herz, Yoshinobu, Alexander, and Lazarus fail to disclose permitting a viewer to take a break from broadcast programming comprising instructions for receiving a delay program selection; and instructions for routing broadcast programming to memory upon receiving the delay program selection.

In analogous art, Daniels discloses permitting a viewer to take a break from broadcast programming (paragraph 0080, lines 8-11) comprising instructions for receiving a delay program selection (pause command from the viewer—paragraph 0080, lines 1-4); and instructions for routing broadcast programming to memory upon receiving the delay program selection (start-recording upon receiving the pause command—paragraph 0021, lines 8-10 and paragraph 0083, lines 1-8).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, Alexander, and Lazarus to include permitting a

viewer to take a break from broadcast programming by use of a delay command, as taught by Daniels, for the benefit of allowing the viewer to take a break from viewing the current channel and/or switch to another channel (paragraph 0080, lines 8-11).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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